

REMARKS

The Final Office Action mailed June 25, 2005, has been received and reviewed. Claims 5-36 and 41-52 were cancelled. Claims 1-4, 37-40, and 53-87 are currently pending in the application. Claims 1-4, 37-40, and 53-87 stand rejected. Applicants have amended claims 1, 37, 53, 62, 75, 79 and 81, and respectfully request reconsideration of the application as amended herein.

Claim Rejections under 35 U.S.C. 103(a)

Claims 1-4, 37-40, and 53-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. U.S. Pat. No. 6,275,693 (Lin) in view of Applicant's admitted prior art. Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 37-40, and 53-87 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claims 1, 37, 53, 62, 75 and 79, Applicants have amended independent claims 1, 37, 53, 62, 75 and 79 to include claim limitations not taught or suggested in the cited reference or Applicants' admitted prior art.

Applicants' independent claim 1, as presently amended, recites, in part, "***provisioning the resource at least partially through the R_m interface***".

Applicants' independent claim 37, as presently amended, recites, in part, "***provisioning the resource at least partially through the R_m interface***".

Applicants' independent claim 53, as presently amended, recites, in part, "the wireless communication device ***provides the selected configuration*** to the mobile terminal ***at least partially through the R_m interface***".

Applicants' independent claim 62, as presently amended, recites, in part, "the mobile station manager dynamically ***provisions at least partially through an R_m interface***".

Applicants' independent claim 75, as presently amended, recites, in part, "the mobile configuration manager ***provisions the resource at least partially through an R_m interface***".

Applicants' independent claim 79, as presently amended, recites, in part, "the first interface to ***configure at least partially through an R_m interface*** the TE2 communication terminal".

Applicants respectfully assert that Lin does not teach or suggest Applicants' invention as presently claimed in amended independent claims 1, 37, 53, 62, 75 and 79. In contrast, Lin, in Figure 1, discloses that a mobile communication device 102 (the "first communication endpoint" in the Examiner's construction) communicates messages with a provisioning proxy 110 (the "mobile station manager" in the Examiner's construction) **not** over an R_m interface as recited in Applicants' amended independent claims 1, 37, 53, 62, 75 and 79, but over a communications link (e.g., U_m interface) that includes an air interface 106, a base station 104, and a wireless network 108. (Lin, FIG. 1; see also col. 3, lines 1-10).

Despite the lack of teaching in Lin, the Examiner has alleged that it would have been obvious to provide an R_m interface for this communications link because "[the R_m interface] would have enabled the mobile device to communicate with other conventional user devices." (Office Action: page 4, fourth paragraph). However, Applicants respectfully

submit that the provisioning proxy 110 disclosed in Lin cannot be understood as a “conventional user device,” as the provisioning proxy is actually “a gateway between the wireless network and a public network.” (Lin, col. 3, lines 16-17). Therefore, the motivation stated by the Examiner does not suggest providing an R_m interface between the appropriate elements as recited in Applicants’ amended independent claims 1, 37, 53, 62, 75 and 79.

Furthermore, while an R_m interface may be well-known in the art, the Examiner has not alleged that it would have been obvious to use such an R_m interface in place of the communications link cited from Lin. In fact, such a construction would not work as the provisioning proxy 110 in Lin is actually located on the other side of the air interface 106, base station 104, and wireless network 108 from the mobile device 102.

As the Examiner has not shown how all claim limitations are taught or suggested by the prior art (see, e.g., MPEP 2143.03), it is respectfully requested that the Examiner withdraw the rejection of independent claims 1, 37, 53, 62, 75 and 79. Therefore, since Lin does not teach or suggest Applicants’ invention as presently claimed in amended independent claims 1, 37, 53, 62, 75 and 79, Lin cannot render obvious, under 35 U.S.C. §103, Applicants’ invention as presently claimed. Accordingly, Applicants respectfully request the rejection of presently amended independent claims 1, 37, 53, 62, 75 and 79 be withdrawn.

The nonobviousness of independent claims 1, 37, 53, 62, 75 and 79 preclude rejections of claims 2-4, 38-40, 54-61, 63-74, 76-78 and 80-87 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 37, 53, 62, 75 and 79 and claims 2-4, 38-40, 54-61, 63-74, 76-78 and 80-87 which respectively depend therefrom.

CONCLUSION

Claims 1-4, 37-40 and 53-87 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

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